

7399-2.JVD.301876

REMARKS

Reconsideration of the present application is respectfully requested.

The Office Action objects to the specification because of the following informalities: headings are missing. Applicant has added the appropriate headings. Applicant respectfully requests withdrawal of this objection.

Claim 23 is objected to because it is not clear what module the Applicant is referring to. Applicant has amended claims 23, 26, 27, and 35 to include a corridor module, and believes that the appropriate clarification has been added.

The rejections under 35 U.S.C. § 102.

Claims 23, 25, and 27 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3, 742,666 to Antoniou.

The examiner has rejected independent claims 23, 25 and 27 on the basis that they are anticipated by Antoniou. Applicant has amended claims 23 and 27. These claims include a corridor module to which inhabitable building modules are connected and using the corridor to route services to the building module. These claims have also been amended to include that the corridor module includes a floor defining a walkway, such that it is possible to walk from the walkway through a connection opening and into a building module.

In Antoniou utility conduits are housed in a "below ground tunnel unit 15" (see column 3, lines 1 to 10) that is coupled to a pan unit 16 and one or more vertical upright stacks 17. The modular tunnel unit 15 has base and side walls and open top wall (see figure 2 and lines 27 to 32 of column 3). After the pan units 16 have been attached to the tunnel unit 15, "the trench for the tunnel is then backfilled"(col. 5, lines 3-4). It is further stated that "the top of the roof of the

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tunnel is then closed over by the floor wall of the building modules mounted thereover" (column 5, lines 4 and 5). There is no disclosure in Antoniou for a walkway that provides access from a tunnel unit to a pan unit. Tunnel unit clearly does not provide direct access to the building modules in the manner as claimed and serves simply as no more than a duct for housing the utility pipes. It cannot therefore be considered as a corridor with a walkway that provides access to the building modules

The amended claim 23 also includes a corridor module and inhabitable building modules so as to better clarify the claim. It also includes the opening in each building module being connected to the opening in the corridor modules and to the walkway linking said openings so that one can walk from the corridor into the building module. There is no such connection in Antoniou. The Office Action refers to "a building module 23 [of Antoniou] being connected to a connection node (lowermost on the right)" in the third paragraph on page 3 of the office action. Applicant believes that a fair reading of Antoniou does not show the claimed structure of a connection of the first end of the building module to the corridor module such that the respective openings are in communication. The only connection between the two modules in Antoniou would appear to be the indirect connection between the upper opening 71 in the tunnel and ports in the sidewalls of the building modules via the pan unit 16 and the stack 17.

The rejections under 35 U.S.C. § 103.

Claims 24, 28-31, 35-36, 48, and 50-69 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,742,666 to Antoniou.

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In relation to claim 24 and 48, there is no suggestion in Antoniou of routing the services from under the floor or above the ceiling in the corridor module. Instead, Antoniou only discloses the separate ducts as shown in Fig. 1.

The Office Action states that it would have been obvious to one having ordinary skill to transform the vertical orientation of Antoniou to the claimed routing in floor and ceiling cavities. Applicant disagrees with these rejections. A critical step in analyzing the patentability of claims pursuant to § 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. In re Kotzab 55 U.S.P.Q. 2nd 1313, 1316 (CAFC, 6/30/00).

In Kotzab, the Examiner and the Board of Patent Appeals and Interferences rejected claims directed to the use of a single temperature sensor to control multiple flow control valves, which the CAFC characterized as "a technologically simple concept." The PTO rejection was based on a reference which included multiple temperature sensors to control multiple valves. The CAFC reversed the PTO rejection and determined that:

... the Examiner and the Board fell into the hindsight trap ... [T]here was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed. Kotzab at 1318.

In the pending application, claims 24 and 48 each include that the service module has floor and ceiling cavities in which the mains service supplies are routed, and that the building modules have floor and ceiling cavities for receipt of the mains service supplies. . In contrast, Antoniou provides for vertical orientation of services, and no where teach or suggests any other orientation. Just as in Kotzab, the rejection of the Office Action appears to be based on hindsight, and Applicant respectfully requests withdrawal of the rejections.

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Claims 32, 33, 44, 45, 46, 47, and 49 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,742,666 to Antoniou in view of U.S. Patent No. 3,292,327 to Van der Lely.

The examiner has rejected claims 32, 33, 44 to 47 and 49 on the ground that they are unpatentable over Antoniou in view of van der Lely. Applicant respectfully disagrees with these rejections.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2142. Claim 32 includes a flexible resilient insert that bridges the two modules. Claim 33 includes a resilient flexible insert attached to one module and received in an aperture of the vertically adjacent module.. Claim 45 includes a flexible resilient insert bridging the building modules. Claim 47 includes a flexible resilient insert bridging the building modules. Neither Van der Lely nor Antoniou show a flexible resilient insert as claimed. Further, neither of these references show any suggestion or motivation to make the modification.

Van der Lely shows a connection arrangement (figure 6) between two vertically stacked building modules in which a nut and bolt connection are disposed in recesses in wall of adjacent modules and used to interconnect the modules. Only a rigid, bolted connection is shown. Further, Van der Lely discloses the use of tie rods "so that elements are rigidly held relatively to each other" (col. 6, lines 29-31). To further increase the rigidity of the final structure, Van der Lely shows an arrangement of grooves 130 and tongues 131 that closely fit into each other (Fig.

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7; col. 6, lines 25-28). Van der Lely teaches only a rigid attachment, and provides no motivation for any flexibility.

Further, modifying the disclosure of Antoniou will render Antoniou unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01.

Applicant disagrees with the statement in the Office Action that Antoniou "does not disclose the precise way by which the modules are connected." To the contrary, Antoniou discloses that his vertical stack 17 is positioned relative to the building units "in accordance with that described in my heretofore referred to application Ser. No. 157,402 filed June 28, 1971" (col. 7, lines 47-55 or the '666 patent). This application issued as U.S. Patent No. 3,822,519, and precisely discloses Antoniou's intended purposes, as described in his own words.

Antoniou's '519 patent describes a building system of "positively intertie[d] adjacent units" (Abstract) such as two, side-by-side module units 20 and 20a (col. 5, lines 23-25; Fig. 2). These modular units are tied together by column units 21 and 30 (col. 6, lines 51-61; Fig. 5). These column sections are positively interlocked to each other (from col. 8, line 58-62; Fig. 5, 8, and 9). Only rigid interconnecting bolts are shown. Nowhere in Antoniou '519 can Applicant find reference to any flexibility in the module interconnections.

Modifying Antoniou '666 to include a flexible bridging between modules would render Antoniou unsatisfactory for its intended purpose. Antoniou expressly contemplated his distribution system of the '666 patent to work in relation to his '519 patent. His '519 patent teaches, shows, and describes only rigid interlocking fastening of modules. Since the proposed

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modification would render Antoniou unsatisfactory for its intended purpose, a prima facie case of obviousness cannot be established and withdrawal of the rejections is respectfully requested.

There is no suggestion in Van Der Lely of interconnecting two fixing members to achieve a flexible module interconnection. It is not simply a case of providing a grommet or insert around a fixing element to act as a cushion, reinforcement or protection. If the skilled person were inclined to use a grommet around a fixing member in the manner suggested by the examiner this would not include all the elements of these claims. The nut and bolt fixing arrangement in Van Der Lely is rigid and provides no flexibility to allow displacement between modules. Simply adding a grommet would not achieve such flexibility as there is no clearance between the walls and the bolt head or shank or nut to allow it. Furthermore, in the context suggested by the examiner the skilled person would only be concerned with protection or cushioning and he would have no reason to adopt a resilient insert of this kind for interconnecting two fixing elements.

Claim 26 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,742,666 to Antoniou in view of U.S. Patent No. 5,755,063 to Ohnishi

Applicant has amended claim 26 to include a corridor module to which inhabitable building modules are connected and using the corridor to route services to the building module. This claim has also been amended to include that the corridor module includes a floor defining a walkway, such that it is possible to walk from the walkway through a connection opening and into a building module. These claim elements cannot be found within Ohnishi, and therefore Applicant respectfully requests withdrawal of the rejection.

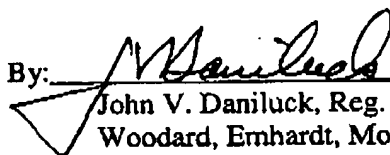
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CLOSING

Applicant has amended claims 23, 26, 27, and 35. Applicant believes that all pending claims are in condition for allowance. Applicant therefore respectfully requests a Notice of Allowance for pending claims 23-36 and 44-69. The undersigned welcomes a telephonic interview with the Examiner, if the Examiner believes that such an interview would facilitate resolution of any outstanding issues.

Respectfully submitted,

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